

RECEIVED
CENTRAL FAX CENTER

007

DUPLICATE

DEC 21 2004

PATENT CASE: AL0425KQ10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE-----X
In re Application of:

Sequeira, et al

: Examiner: Clardy

Serial No.: 10/763,295

: Group Art Unit: 1616

Filed: 1/22/04

For : USE OF MOMETASONE
FUROATE FOR TREATING AIRWAY
PASSAGE AND LUNG DISEASES
-----XCommissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450TERMINAL DISCLAIMER UNDER 37 C.F.R. 1.321 AND FEE UNDER 37
C.F.R. 1.20 (d)

Sir:

Petitioner, Schering Corporation, is the owner of 100% interest in the instant application. Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 36 U.S.C. sections 154 to 156 and 173, as presently shortened by any terminal disclaimer, of commonly-owned U.S. Patent Numbers 6,723,713, 6,677,323, 6,677,322, 6,365,581, 6,057,307, 5,889,015, 5,837,699, and co-pending Patent Application Serial No. 10/763,143. Petitioner hereby agrees that any patent granted on the instant application shall be enforceable only for and during such period that it and any of the aforesaid patent application are commonly-owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the fully statutory term as defined in 35 U.S.C. sections 154 to 156 and 173 of the aforesaid patent application, as presently shortened by any terminal disclaimer, in the event that either one or both later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to

49210_1.DOC

the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Petitioner is the owner of 100% interest in the instant application by virtue of an assignment to Schering Corporation from all the inventors.

The undersigned states that he is empowered to act on behalf of the petitioner under 37 § C.F.R. 1.34.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant or aforesaid applications or any patents issued thereon.

The USPTO is hereby authorized to charge the \$130 fee under 37 C.F.R. §1.20 (d) for the present Terminal Disclaimer to charge account 19-0365. A duplicate of this document is enclosed for your records.

December 21 2004
Schering-Plough Corporation
Patent Department, K-6-1, 1990
2000 Galloping Hill Road
Kenilworth, New Jersey 07033
Tel: 908-298-5066
Fax: 908-298-5388

Respectfully submitted,



Robert J. Lipka
Attorney for Applicant
Reg. No. 42, 807

RECEIVED
CENTRAL FAX CENTER

001

DEC 21 2004

SCHERING-PLOUGH CORPORATION
LAW DEPARTMENT
2000 GALLOPING HILL ROAD
K-6-1, MAIL STOP
KENILWORTH, NEW JERSEY 07033
(908) 298-4000

FACSIMILE TRANSMITTAL SHEET

To
USPTO

FAX NUMBER:
703-872-9306

FROM:
Robert J. Lipka

PHONE NUMBER:
908-298-5056

TOTAL NO. OF PAGES INCLUDING COVER
8

DATE
December 21 2004

CONFIDENTIALITY NOTE: This sheet and/or the document(s) accompanying it contain information belonging to Schering-Plough Corporation and/or its affiliates which is confidential and/or legally privileged. The information is intended only for the use of the individual or entity named above. If you have received this fax in error, please immediately notify us by telephone. If there is a problem with this transmission please call Pia Paras-Sanjurjo at 908-298-3955.

PLEASE HAND DELIVER

In re Application of US Patent Application No. 10/763,295
For Patent For: "Use of Mometasone Furoate for treating..."
Filing Date: 01/22/2004
Our Ref.: AL0425KQ10 US
Applicant: Sequeira et al.

Transmitted herewith are:

- Fax Cover Sheet - 1 Page
- Terminal Disclaimer and Fee - 2 Pages (in duplicate)
- Certificate of Facsimile - 1 page
- Response to Office Action - 2 pages

PHONE: (908)298-3955

FAX: (908)298-5388

Attorney Docket No.: AL0425KQ10

Application No.: 10/763,295

Filing Date: 1/22/2004

First Named Inventor: Sequeira

RECEIVED
CENTRAL FAX CENTER

DEC 21 2004

PTO/SB/97 (05-03)

Approved for use through 07/31/2008. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No.) 703-872-9306

on December 21, 2004

Date


Signature

Robert J. Lipka; Reg. No. 42,807

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Document(s) being transmitted:

Fax Cover Sheet - 1 page

Terminal Disclaimer and Fee - 2 Pages (in duplicate)

Response To Office Action - 2 pages

Certificate of Fax Transmission - 1 page

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

DEC 21 2004

PATENT CASE: AL0425KQ10**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**-----X
In re Application of:

Sequelra, et al

Serial No.: 10/763,295

Filed: 1/22/04

For : USE OF MOMETASONE
FUROATE FOR TREATING AIRWAY
PASSAGE AND LUNG DISEASES
-----X

Examiner: Clardy

Group Art Unit: 1616

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450**TERMINAL DISCLAIMER UNDER 37 C.F.R. 1.321 AND FEE UNDER 37**
C.F.R. 1.20 (d)

Sir:

Petitioner, Schering Corporation, is the owner of 100% interest in the instant application. Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 36 U.S.C. sections 154 to 156 and 173, as presently shortened by any terminal disclaimer, of commonly-owned U.S. Patent Numbers 6,723,713, 6,677,323, 6,677,322, 6,365,581, 6,057,307, 5,889,015, 5,837,699, and co-pending Patent Application Serial No. 10/763,143. Petitioner hereby agrees that any patent granted on the instant application shall be enforceable only for and during such period that it and any of the aforesaid patent application are commonly-owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the fully statutory term as defined in 35 U.S.C. sections 154 to 156 and 173 of the aforesaid patent application, as presently shortened by any terminal disclaimer, in the event that either one or both later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to

49210_1.DOC

the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Petitioner is the owner of 100% interest in the instant application by virtue of an assignment to Schering Corporation from all the inventors.

The undersigned states that he is empowered to act on behalf of the petitioner under 37 § C.F.R. 1.34.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant or aforesaid applications or any patents issued thereon.

The USPTO is hereby authorized to charge the \$130 fee under 37 C.F.R. §1.20 (d) for the present Terminal Disclaimer to charge account 19-0365. A duplicate of this document is enclosed for your records.

December 21 2004
Schering-Plough Corporation
Patent Department, K-6-1, 1990
2000 Galloping Hill Road
Kenilworth, New Jersey 07033
Tel: 908-298-5066
Fax: 908-298-5388

Respectfully submitted,



Robert J. Lipka
Attorney for Applicant
Reg. No. 42, 807